

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 34

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KAZUO KONISHI, SHIMPEI YOSHIOKA, KOJI
MARUYAMA, TOMOYUKI MAEKAWA, and TOSHIAKI SATO

Appeal No. 1998-0063
Application No. 08/057,805

HEARD: February 24, 2000

Before KRASS, JERRY SMITH, and GROSS, Administrative Patent
Judges.

GROSS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 4 and 7 through 18. Claims 5 and 6 have been canceled. In an After Final amendment filed April 28, 1997, claim 18 was canceled. Accordingly, claims 1 through 4 and 7 through 17 remain before us on appeal.

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Appellants' invention relates to a memory card device in which a data relief area is created when and if a defective area, one into which data cannot be successfully written, is detected in the storage area. Claim 15 is illustrative of the claimed invention, and it reads as follows:

15. A memory card device comprising:

a storage area divided into a plurality of space blocks, each of said space blocks including a predetermined number of memory cells; and

a data control circuit which creates a data relief area in said storage area if and when it detects that data can not be successfully written into a defective area in said storage area, said data control circuit creating said data relief area by locating and identifying a predetermined number of space blocks in said storage area and writing data destined for said defective area instead into said data relief area, said data control circuit being operative such that said storage area contains no data relief areas before said defective area is detected.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Harari et al. (Harari)	5,297,148	Mar. 22,
1994		

Claims 1 through 4 and 7 through 17 stand rejected under 35 U.S.C. § 103 as being unpatentable over Harari.

Reference is made to the Examiner's Answer (Paper No. 26, mailed July 17, 1997) for the examiner's complete reasoning in

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support of the rejections, and to appellants' Brief (Paper No. 25, filed April 24, 1997) and Reply Brief (Paper No. 27, filed September 17, 1997) for appellants' arguments thereagainst.

OPINION

As a preliminary matter we note that appellants have indicated on page 4 of the Brief that all of the claims are to stand or fall together except for claim 15. We agree with appellants' grouping and, therefore, will treat claim 15 as one group and the remaining claims as a second group with claim 1 as representative.

We have carefully considered the claims, the applied prior art reference, and the respective positions articulated by appellants and the examiner. As a consequence of our review, we will reverse the obviousness rejection of claims 1 through 4 and 7 through 17.

Claim 15 calls for "a data control circuit which creates a data relief area in said storage area if and when it detects that data can not be successfully written into a defective area in said storage area." Harari discloses a built-in spare portion for replacing defective cells. In other words, Harari does not create a data relief area when and if a defect is

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detected, but rather includes such an area regardless of whether defects are detected. The examiner asserts (Answer, page 3) that it would have been obvious to the skilled artisan to modify Harari to "generate back-up storage only when needed."

In a rejection under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is required to provide a reason from some teaching, suggestion or implication in the prior art as a whole, or knowledge generally available to one of ordinary skill in the art, why one having ordinary skill in the pertinent art would have been led to modify the prior art to arrive at the claimed invention. Uniroyal, Inc. v. Rudkin-Wiley, 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

In the present case, the examiner has provided no secondary references for a teaching, suggestion, or implication as to why the skilled artisan would have modified Harari. The examiner's motivation for modifying Harari is to improve the efficiency of the device by creating back-up space as needed, thereby not wasting memory space. Although the motivation for modifying a reference may come from common knowledge in the art, the examiner's reasoning comes straight from appellants' objects of the invention (Specification, pages 7-8). The examiner contends (Answer, page 4) that similar techniques are used in other environments, but provides no evidence to corroborate his assertions. Thus, the examiner clearly has engaged in impermissible hindsight. Accordingly, we cannot sustain the rejection of claim 15.

Claim 1 similarly recites a means for creating a data relieving area when and if a defect is detected. As explained above, the examiner has failed to provide adequate motivation for modifying Harari to meet such a limitation. Claim 1 also recites a means for creating a second data relieving area when and if the first area is full and a defect is detected. Harari discloses remapping an entire sector to another sector

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if the alternative defects data area in the first sector is full. The examiner states (Answer, page 8) that Harari's substituting a replacement sector for a defective sector is the motivation for creating a second relief area when a first one is full. However, we fail to see how a teaching to replace the entire sector would have motivated the skilled artisan to create a second alternative defects area within the same sector. The two methods for dealing with a full relief area are quite different. Again the examiner has provided no basis for the particular modification. Therefore, we cannot sustain the rejection of claim 1 nor the claims grouped therewith, claims 2 through 4, 7 through 14, 16, and 17.

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CONCLUSION

The decision of the examiner rejecting claims 1 through 4
and 7 through 17 under 35 U.S.C. § 103 is reversed.

REVERSED

ERROL A. KRASS)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
JERRY SMITH)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
ANITA PELLMAN GROSS)	
Administrative Patent Judge)	

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